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Arieh Don

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EXAMINER

FILIPCZYK, MARCIN R

ART UNIT

PAPER NUMBER

2163

MAIL DATE

DELIVERY MODE

02/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/749,692

Applicant(s)

DON ET AL.

Examiner

Marc R. Filipczyk

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

This Action is responsive to Applicant's response filed on December 5, 2007.

Claims 1-17 are pending.

To expedite the process of examination Examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. amendments, 35 U.S.C. 112, objections and the like) set forth by the Examiner that Applicants provide and link to the most specific page and line numbers of the disclosure where the best support is found (see 35 U.S.C. 132).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 14 and 15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth whether the invention accomplishes a practical application and whether it generates a useful, concrete and tangible result.

The guidelines explain that a practical application of a 35 U.S.C. 101 judicial exception is claimed if the claimed invention physically transforms an article or physical object to a different state or thing, or if the claimed invention otherwise produces a useful, concrete, and tangible result.

In the present case, independent claim 14 does not involve transformation of article or physical object to a different state or thing, it merely recites associating data. Further, independent claim 14 does not produce a useful, concrete, and tangible result, but merely

Art Unit: 2163

maintains data, however no useful, concrete and tangible result is created and stored usability.

State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02.

Claim 14 taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is descriptive material per se, do not comprise a practical application as explained above hence is nonstatutory.

Since the claimed invention, as a whole, does not comprise a practical application as explained above, claim 15 which depends from claims 14, is deemed to be directed to non-statutory subject matter.

Claim Objections

Claims 9-13 and 17 are objected to because of the following informalities:

First, the segment "I/O" should be replaced with Input/Output to clarify the meaning of I/O. Second, the limitation "executing the I/O transaction" or "execute the I/O transaction" should be rewritten to replace transaction with request or its equivalent with request.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Furuike (U.S. Patent No. 6,947,944).

Regarding claims 1, 7-9, 14, 16 and 17, Furuike discloses a storage system, method and program that stores records and ancillary data, comprising (fig.1):

maintaining at the data storage system, information for distinguishing between extents of a logical device (fig. 2, item 7, *controller*), the logical device having a first set of extents designated for storage of database records and a second set of extents designated for storage of ancillary data (fig. 2, item 11 *database definition file* [comprises a plurality of rules] and *classifying*, item 7, see col. 4, lines 20-24); and

(*Note: data other than records is equated with records that are not searched classified as such*)

determining that target location is on an extent designated for storage of a record and not on an extent that is designated for storage of ancillary data, whereby the record is written only to an extent that is designated for storage of a record (fig. 2, item 10, col. 5, lines 29-50) and outputting data (fig. 6, step C8, *output*).

Regarding claims 2, 3, 11, 15 Furuike discloses an extent table identifying properties associated with the extent (fig. 2, item 11 and related text) and verification steps (fig. 3, steps A1-A5).

Regarding claim 4 Furuike discloses a logical device for records (designated for storage of records (fig. 2, item 7, *controller*)).

Regarding claims 5 and 6, Furuike discloses the set of data verification steps depends on whether extent is for storing records or ancillary data (fig. 2, item 11' and related text).

Regarding claim 10, Furuike discloses a write request (fig. 2, item 13, *input* and col. 5, lines 29-36).

Regarding claim 12, Furuike discloses the extents do not overlap (fig. 3, items A6-1 to A6-n, and related text).

Regarding claim 13, Furuike discloses the extents overlap are compatible (figs. 2 and 3, items 11 and A4-A8).

Response to Arguments

Applicant's arguments filed on December 5, 2007 have been fully considered but they are not persuasive. The arguments and responses are listed below.

Applicant argues on page 9 that claim 14 is a "data storage system" therefore it is statutory.

Examiner disagrees. Claim 14 does not claim any hardware components and is therefore rejected as software per se.

Art Unit: 2163

Applicant argues on pages 11 and 12 that Furuike does not teach "a first set of extents" and "a second set of extents".

Examiner disagrees. Applicant should submit an argument under the heading "Remarks" pointing out disagreements with the examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them. Furuike clearly discloses storing and processing records for searching differently from other data using attributions and definitions (see figs. 2, 3 and 5 and rejection above).

With respect to all the pending claims 1-17, Examiner respectfully traverses Applicants assertion based on the discussion and rejection cited above.

Conclusion

This Application has been transferred to Examiner Marcin Filipczyk.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following prior art shows the state of art with respect to managing records:

U.S. Patent No. 6,070,164 of Vagnozzi

U.S. Patent No. 7,194,454 of Hansen et al.

U.S. Publication No. 2003/0093567 of Lolayekar et al.

Art Unit: 2163

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R. Filipczyk whose telephone number is (571) 272-4019. The examiner can normally be reached on Mon-Fri, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2163

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MF
February 6, 2008


DON WONG
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